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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,529	10/27/2003	Sharif Alexander Hamdan	10626	1898

7590 04/07/2005

National IP Rights Center, LLC
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EXAMINER

MAI, TRI M

ART UNIT PAPER NUMBER

3727

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,529

Applicant(s)

HAMDAN, SHARIF ALEXANDER

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). In this case, the provisional application 60/429678 and the present application are not the same disclosure. Inter alias, the provisional application fails to show the elastomeric loop, the tie string, and the material as set forth in the present application.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first and second affixing means being tie string in claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

4. Claims 1, 2, 6, 7, 9, 13, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hinchliff (2035384). Hinchliff teaches a cover with decoration (pg. 2, col. 1, ln. 65-67) having two end with elastomeric loops at two ends (pg. 2, col. 2, ln. 33, 43, 50-55; Figs. 18, 12, 13, 14).

It is noted that it is an intended use to using the cover with a trash receptacle. Furthermore, it is noted that the Hinchliff disclose several receptacles (pg. 1, col. 1, ln. 9-11) that are considered as trash receptacle as claimed, i.e., they can contain trashes.

With respect to the ledge in claim 17, the cover in Hinchliff is capable of forming a ledge due to its flexibility as claimed.

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5. Claims 1-2, 7, 9, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warnberg (D214288) in view of either Hinchliff or Rosenthal (5553733). Warnberg teaches a cover with two ends each forming a ledge as shown in Fig. 1. Warnberg meets all claimed limitations except for the elastomeric material.

Either Hinchliff or Rosenthal teaches that it is known in the art to provide elastomeric material for securing the cover. It would have been obvious to one of ordinary skill in the art to provide elastomeric material at two ends in Warnberg as taught by either Hinchliff or Rosenthal for securing the cover to the receptacle.

6. Claims 3, 5, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Warnberg rejection, as set forth above, and further in view of Szuszkiewicz (2003/0010415). It would have been obvious to one of ordinary skill in the art to use plastic in the cover of Warnberg as taught by Szuszkiewicz to provide the desired material for the cover.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Warnberg rejection, as set forth above in paragraph 5, and further in view of either Moone (1479151) or Riggs et al. (5439727). It would have been obvious to one of ordinary skill in the art to use tie strings in the cover of Warnberg as taught by either Riggs et al. or Moone to provide the alternative securing means.

8. Claims 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by either Moone (1479151) or Riggs et al. (5439727). Either Moone or Riggs teaches a tube (note that in the covering position the covering of Moone formed into a tube as claimed) with first and second securing means being tie strings and note the ledge can be formed by the cover as claimed.

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9. Claims 1, 3, 5, 7, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Garofalo et al. (6508282). Garofalo teaches a cover with decoration having at least one end with elastomeric loop.

10. Claims 3-5, and 10-12 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Hinchliff or Gerofalo in view of Bassi (4589149). Bassi teaches that it is known in the art to provide a cover from plastic and paper (col. 1, ln. 57-57). It would have been obvious to one of ordinary skill in the art to make the cover from paper in either Hinchliff or Gerofalo as taught by Bassi to provide the desired material.

11. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group 1: the cover shown in Fig. 1 (elastomeric), and

Group 2: the cover shown in Fig. 2B (tie string).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (571)272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai
Primary Examiner
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